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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/068,592	05/14/98	MORITA	XIF5334USC

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IM62/0426

EXAMINER

WEINER, L

ART UNIT	PAPER NUMBER
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1745

DATE MAILED:

04/26/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/068,592**

Applicant(s)  
**Morita et al.**

Examiner  
**Laura Wein r**

Group Art Unit  
**1745**



☒ Responsive to communication(s) filed on Mar 16, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1, 3-7, and 9-39 is/are pending in the applicat

Of the above, claim(s) 13-22 and 28-37 is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1, 3-7, 9-12, 23-27, 38, and 39 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of Group I, claims 1-12, 23-27 in Paper No. 6 is acknowledged.
2. Claims 13-22, 32-37 and 28-31 are withdrawn from further consideration by the examiner, as being drawn to a different inventive concept under PCT Rule 13.1 , the requirement having been traversed in Paper No. 6.

### ***Claim Objections***

3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 28-29 have been renumbered 38-39.

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***Response to Amendment***

4. Examiner acknowledges the cancellation of claims 2 and 8 and addition of claims 38-39 cited in Amendment B dated 3-16-2000. Claims 1, 3-7, 9-12, 23-27, 38-39 have been examined on their merits.

***Response to Arguments***

5. Applicant's arguments filed March 16, 2000 have been fully considered but they are not persuasive. Applicant argues that Miyabayashi et al. teaches covering a core material with a mixture of solvent and organic compound which fails to suitably cover a core carbon material with tar or pitch and that Miyabayashi et al. teaches that the vapor phase process has a drawback of insufficient deposition but this is not cited in the claims. Therefore the rejection still stands.

***Claim Rejections - 35 USC § 112***

6. Claims 23-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 23-26 are rejected because it is unclear how the coated carbon material can be produced according to claim 1 when claim 1 is a product claim and not a process claim. It would be clearer for example if claim 23 was written to state, "A method for producing the coated carbon material of claim 1, characterized that the method comprises calcining the coated carbon

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material for carbonization.” This would solve the rejection of an unclear method claim and would now claim the method step(s).

***Claim Rejections - 35 USC § 102***

7. Claims 1, 5; 7, 11 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 8-104510, abstract.

JP 8-104510 teaches a carbon composite material with a multilayer structure which consists of carbonaceous particles which are wholly or partially coated with a carbon material having a true density of at least 1.80 g/cm<sup>3</sup>, a BET specific surface area of up to 30 m<sup>2</sup>/g and an average particle diameter of up to 35 microns. JP 8-104510 teaches dispersing carbonaceous particles in a heavy oil to bring them into contact and to allow the surface and pores of the carbonaceous particles to be impregnated with or adsorb the polycyclic aromatic molecules.

***Claim Rejections - 35 USC § 103***

8. Claims 1, 3-5, 38; 7, 9-11, 39; 23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Miyabayashi et al. (EP 0 549 802 A1).

Miyabayashi et al. teaches an electrode for secondary batteries which comprises a carbonaceous material of the multilayer structure comprising a surface layer and the nucleus enveloped therein and satisfies the following conditions: (1) a true density of not less than 1.80

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g/cm<sup>3</sup>, etc. Miyabayashi et al. teaches on page 2, line 57 to page 3, line 3, that the carbonaceous material should most preferably be 2.20-2.23 g/cm<sup>3</sup>. Miyabayashi et al. teaches on page 5, lines 5-14, that d<sub>002</sub> is 3.35 to 3.45 Å. Miyabayashi et al. teaches on page 6, lines 10-11, 12-14, that the diameter is 1-25 μm and the length is preferably 10 mm or shorter, more preferably 5 mm or shorter and that the specific surface area is most preferably 2-8 m<sup>2</sup>/g.

In the event any differences can be shown for the product of the product by process claims 38-39, as opposed to the product taught by Miyabayashi et al., such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results. *In re Thrope* 227 USPQ 964; (*Fed. Cir.* 1985).

With respect to the product by process claims 38-39, the determination of patentability is based upon the product itself not upon the method of its production. *In re Thrope* 227 USPQ 964; *In re Brown* 173 USPQ 685; *In re Bridgeford* 149 USPQ 55; *In re Wertheim* 191 USPQ 90. Any difference imparted by the product by process limitations would have been obvious to one having ordinary skill in the art at the time the invention was made because where the Examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to the Applicants to establish that their product is patentably distinct. *In re Brown* 173 USPQ 685 and *In re Fessmann* 180 USPQ 324.

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9. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyabayashi et al. (EP 0 549 802 A1).

Miyabayashi et al. teaches an electrode for secondary batteries which comprises a carbonaceous material of the multilayer structure comprising a surface layer and the nucleus enveloped therein. Miyabayashi et al. teaches on page 6, lines 10-11, 12-14, that the diameter is 1-25  $\mu\text{m}$  and more preferably 2-20  $\mu\text{m}$  and the length is preferably 10 mm or shorter, more preferably 5 mm or shorter and that the specific surface area is most preferably 2-8  $\text{m}^2/\text{g}$ .

Miyabayashi et al. discloses the claimed invention as explained above except for specifically teaching that the volume-based integrated value of particles having a diameter of 1  $\mu\text{m}$  or less is 10% or less.

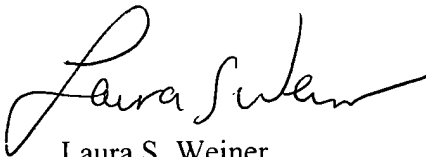
It would have been obvious to one having ordinary skill in the art at the time the invention was made to have 10% or less of particles having a diameter of 1  $\mu\text{m}$  or less because since it has been held that where general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura Weiner whose telephone number is (703) 308-4396. The examiner can normally be reached on Monday-Friday from 7:30 a.m. to 4:00 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Maria Nuzzolillo, can be reached on (703) 305-3776. The official fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in cursive script, reading "Laura S. Weiner". The signature is written in dark ink and is positioned above the printed name and title.

Laura S. Weiner  
Patent Examiner  
Art Unit 1745  
April 25, 2000